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OFFICE OF PETITIONS

In re Application :  
Atherton, et al. :  
Application No. 09/891,206 : DECISION ON APPLICATION  
Filed: June 26, 2001 : FOR PATENT TERM ADJUSTMENT  
Atty Docket No. 20342/0202324-US0 :

This is a decision on the "REQUEST FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §§ 1.705(b)," filed February 2, 2006. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to sixty (60) days.

For the reasons set forth below, a decision on the request for reconsideration of the patent term adjustment indicated on the patent is being **HELD IN ABEYANCE** until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

On November 2, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On February 2, 2006, applicants timely<sup>1</sup> submitted an application for patent term adjustment, asserting that the correct number of days of PTA is sixty (60) days.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment of thirty-seven (37) days of PTO delay pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), and applicants' delays of ninety-one (91), thirty-one (31), and ninety-one (91) days, all pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). All periods of adjustment have been reviewed and found to be correct.

However, applicants assert additional PTO delay of three hundred five (305) days for the failure on the part of the Office to issue the patent within three years of its filing. The Office will be able to assess whether or not any additional PTA is accorded once the issue date is established.<sup>2</sup>

In addition, applicants have also directed the Office's attention to another adjustment for applicant delay. A Notice of Allowance was mailed on January 31, 2005. Applicants filed an RCE on April 27, 2005, and assert that they should have been assessed delay of sixty-seven (67) days pursuant to 37 C.F.R. § 1.704(c)(10). However, an RCE is a proper response to a Notice of Allowance, and accordingly applicants should not be assessed any delay for its filing. However, applicants should have been assessed applicant delay of forty-three (43) days pursuant to 37 C.F.R. § 1.704(c)(8) for the filing of an Amendment on June 9, 2005.

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<sup>1</sup> Applicants filed the application for patent term adjustment prior to paying the issue fee.

<sup>2</sup> Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0) days** (37 days of PTO delay, reduced by 256 (43+31+91+91) days of applicant delay).

Receipt of the \$200 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

*Kery A Fries*

Kery Fries  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy

Day : Monday  
Date: 4/10/2006 **PALM INTRANET**

Time: 14:45:45

**PTA Calculations for Application: 09/891206**

Application Filing Date:	06/26/2001	PTO Delay (PTO):	37
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	213
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-43		

**File Contents History**

Number	Date	Contents Description	PTO	APPL	START
78	04/10/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		43	
70	11/02/2005	MAIL NOTICE OF ALLOWANCE			
69	11/01/2005	ISSUE REVISION COMPLETED			
68	11/01/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
67	10/31/2005	NOTICE OF ALLOWABILITY			
66	10/05/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	64
65	10/28/2005	DATE FORWARDED TO EXAMINER			
64	10/05/2005	RESPONSE AFTER NON-FINAL ACTION			
63	07/05/2005	MAIL NON-FINAL REJECTION			
62	07/01/2005	NON-FINAL REJECTION			
61	06/29/2005	DATE FORWARDED TO EXAMINER			
60	04/27/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
59	06/29/2005	DATE FORWARDED TO EXAMINER			
58	04/27/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
57	06/29/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
56	04/27/2005	MISCELLANEOUS INCOMING LETTER			
55	06/29/2005	MAIL ACKNOWLEDGEMENT OF PRIORITY PAPERS			
54	06/29/2005	ACKNOWLEDGEMENT OF PRIORITY PAPERS			
53	04/27/2005	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
52	06/29/2005	MAIL RESPONSE TO 312 AMENDMENT (PTO-271)			

51	06/29/2005	RESPONSE TO AMENDMENT UNDER RULE 312			
50	06/09/2005	AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312)			
49	06/29/2005	CORRESPONDENCE ADDRESS CHANGE			
48	06/29/2005	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
47	04/27/2005	WORKFLOW - REQUEST FOR RCE - FINISH			
46	06/17/2005	RECEIPT INTO PUBS			
45	05/26/2005	WORKFLOW - QUERY REQUEST - FINISH			
44	05/16/2005	WORKFLOW - QUERY REQUEST - BEGIN			
43	04/27/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
42	02/07/2005	EXPORT TO INITIAL DATA CAPTURE			
41	02/17/2005	WORKFLOW - FILE SENT TO CONTRACTOR			
40	01/31/2005	MAIL NOTICE OF ALLOWANCE			
39	01/31/2005	MAIL EXAMINER'S AMENDMENT			
38	01/28/2005	ISSUE REVISION COMPLETED			
37	01/28/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
36	01/28/2005	CASE DOCKETED TO EXAMINER IN GAU			
35	01/28/2005	EXAMINER'S AMENDMENT COMMUNICATION			
34	01/28/2005	NOTICE OF ALLOWABILITY			
33	12/08/2004	DATE FORWARDED TO EXAMINER			
32	11/12/2004	RESPONSE AFTER NON-FINAL ACTION		31	29
31	11/12/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
30	11/12/2004	WORKFLOW INCOMING AMENDMENT IFW			
29	07/12/2004	MAIL NON-FINAL REJECTION			
28	07/09/2004	NON-FINAL REJECTION			
27	05/04/2004	DATE FORWARDED TO EXAMINER			
26	04/21/2004	RESPONSE AFTER NON-FINAL ACTION		91	22
25	04/21/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
24	11/16/2001	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
23	04/21/2004	WORKFLOW INCOMING AMENDMENT IFW			
22	10/21/2003	MAIL NON-FINAL REJECTION			
21	10/20/2003	NON-FINAL REJECTION			
20	08/11/2003	DATE FORWARDED TO EXAMINER			
19	07/29/2003	RESPONSE AFTER NON-FINAL ACTION		91	17

18	07/29/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
17	01/29/2003	MAIL NON-FINAL REJECTION			
16	01/27/2003	NON-FINAL REJECTION			
15	11/21/2002	DATE FORWARDED TO EXAMINER			
14	11/04/2002	RESPONSE TO ELECTION / RESTRICTION FILED			
13	10/02/2002	MAIL RESTRICTION REQUIREMENT	37		-1
12	10/01/2002	REQUIREMENT FOR RESTRICTION / ELECTION			
11	07/10/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	05/09/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	02/27/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	06/26/2001	PRELIMINARY AMENDMENT			
7	11/28/2001	APPLICATION DISPATCHED FROM OIPE			
6	11/27/2001	APPLICATION IS NOW COMPLETE			
4	08/22/2001	NOTICE MAILED--APPLICATION INCOMPLETE-- FILING DATE ASSIGNED			
3	08/21/2001	CORRESPONDENCE ADDRESS CHANGE			
2	07/05/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	06/26/2001	INITIAL EXAM TEAM NN			

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### EXPLANATION OF PTA CALCULATION

### EXPLANATION OF PTE CALCULATION

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Dated: \_\_\_\_\_

Docket No.: 20342/0202324-USO  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Nigel Atherton *et al.*

Allowed: November 2, 2005

Application No.: 09/891,206

Confirmation No.: 9337

Filed: June 26, 2001

Art Unit: 1616

For: Treatment of Bone Diseases

Examiner: John D. Pak

**REQUEST FOR PATENT TERM  
ADJUSTMENT UNDER 37 C.F.R. §§ 1.705(b)**

MS Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants, through the undersigned attorneys/agents, hereby request reconsideration of the Patent Term Adjustment ("PTA") indicated in the Notice of Allowance for this application. Applicants respectfully submit that the PTA indicated in the Notice of Allowance is incorrect, and that the correct Patent Term Adjustment to date (February 2, 2006) is actually **60 days**. A detailed statement of the facts involved is set forth below, starting on page 3 of this document, and pursuant to the requirements of 37 C.F.R. §§ 1.705(b)(2)(i) - (iv).

The Issue Fee Transmittal and amendment under 37 C.F.R. §1.312 for this patent application accompany this submission, along with a check in the amount of **\$1,900.00** for payment of (i) the Issue and Publication Fees (\$1,700.00); and (ii) the \$200.00 fee required under 37 C.F.R. §§ 1.705(b)(1) and 1.18(e). A copy of the following document is also attached hereto, for the Examiner's convenience when considering this request:

02/07/2006 WABDEL3 00000045 09891206 200.00 DP  
03 FC:1455

**Tab A:** the USPTO's Patent Term Adjustment ("PTA") History for this application, as downloaded from the Patent Application Information Retrieval (PAIR) WEB site on February 1, 2006;

It is believed that no additional fee is required for this submission. However, should the U.S. Patent and Trademark Office determine that any additional fee is required or that a refund is due for this application, then the Commissioner is hereby authorized and requested to charge the required fee(s) and/or credit any refund(s) due to the above-mentioned Deposit Account No. 04-0100.



## **STATEMENT OF THE FACTS INVOLVED**

### **A. Statement of the Correct Patent Term Adjustment (37 C.F.R. § 1.705(b)(2)(i))**

On November 2, 2005, the U.S. Patent and Trademark Office mailed a Notice of Allowance for this application stating that “[t]he Patent Term Adjustment to date [November 2, 2005] is 0 day(s).” The Notice of Allowance also states that:

If the issue fee is paid on the date that is three months after the mailing date of this notice [*i.e.*, on February 2, 2006] and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice [*i.e.*, on May 16, 2006], the Patent Term Adjustment will be 0 days.

The detailed Patent Term Adjustment History calculated by the U.S. Patent and Trademark Office for this application (hereinafter referred to as the “PTA History”)<sup>1</sup> is attached hereto at Tab A, and reveals that the Patent and Trademark Office calculated a patent term adjustment of 37 days for “USPTO delay,” reduced by 213 days for “applicant delay.”

The U.S. Patent and Trademark Office’s calculation of the Patent Term Adjustment is incorrect, as explained in detail below. The correct Patent Term Adjustment to date (February 2, 2006) is **60 days**. Applicants assert that the correct amount of Patent Term Adjustment is the difference between the sum of the periods calculated under 37 C.F.R. § 1.703(a)-(e) (*i.e.*, **342 days**) less the sum of the periods calculated under 37 C.F.R. § 1.704 (*i.e.*, **282 days**). *See*, 37 C.F.R. § 1.703(f).

### **B. Bases under 37 C.F.R. §1.702 for the Adjustment and The Relevant Dates For Which an Adjustment Is Sought (37 C.F.R. §§ 1.705(b)(2)(i) and (ii))**

Applicants assert the following bases under 37 C.F.R. §1.702 for the adjustment and the relevant dates for which an adjustment is sought under 37 C.F.R. §1.703(a)-(e):

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<sup>1</sup> The PTA History was downloaded from the Patent Application Information Retrieval (PAIR) WEB site on February 1, 2006.

(1) Under 37 C.F.R. § 1.703(a)(1), the period of adjustment includes the number of days in the period beginning on the day after the date that is 14 months after the date on which the application was filed under 35 U.S.C. § 111(a) and ending on the date of mailing of an action under 35 U.S.C. § 132. In the instant application, the PTA History shows the correct period of adjustment, *i.e.*, **37 days** (or the period starting on the day after the date that is 14 months after filing the application (*i.e.*, August 27, 2002) and ending on the date of mailing the Restriction Requirement (*i.e.*, October 2, 2002)).

(2) Under 37 C.F.R. § 1.703(b)(1), the period of adjustment includes the number of days in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a) and ending on the date the patent issues, but not including the number of days in the period beginning on the date on which a request for continued examination of the application under 35 U.S.C. § 132(b) was filed and ending on the date the patent is issued. Therefore, Applicants are entitled to a period of adjustment starting on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. § 111(a) (*i.e.*, June 27, 2004) and ending on the date on which the request for continued examination of the application under 35 U.S.C. § 132(b) was filed (*i.e.*, April 27, 2005). This period is **305 days**.

(3) Applicants reserve the right to request a reconsideration of patent term adjustment determination under 37 C.F.R. § 1.705(d), if the patent issues from this application later than 4 months after the issue fee was paid and all outstanding requirements are satisfied. *See* 37 C.F.R. § 1.703(a)(6).

(4) Because the periods discussed above in (1; August 27, 2002 to October 2, 2002) and (2; June 27, 2004 to April 27, 2005) do not overlap, Applicants believe that the correct amount of patent term adjustment is **342 days** (*i.e.*, the sum of the periods discussed in (1) above (37 days) and (2) above (305 days) (37 days + 305 days = 342 days)) **less the sum of the periods calculated under 37 C.F.R. § 1.704**, as calculated below. *See*, 37 C.F.R. § 1.703(f).

**C. Statement Regarding Terminal Disclaimer  
(37 C.F.R. 1.705(b)(2)(iii))**

This application is not subject to any terminal disclaimer.

**D. Statement of Circumstances Constituting a Failure to  
Engage in Reasonable Efforts to Conclude Prosecution  
(37 C.F.R. § 1.705(b)(2)(iv))**

Applicants assert that the following reductions apply to the period of adjustment of patent term under 37 C.F.R. § 1.704:

(1) Under 37 C.F.R. § 1.704(b) and as revealed by the PTA History, the 3-month extension of time requested in response to the Office Action mailed January 29, 2003 (91 days); the 3-month extension of time requested in response to the Office Action mailed October 21, 2003 (91 days); and the 1-month extension of time requested in response to the Office Action mailed July 12, 2004 (31 days), are failures to engage in reasonable efforts to conclude prosecution. The sum of these extensions is **213 days** ( $91 + 91 + 31 = 213$  days).

(2) Under 37 C.F.R. § 1.704(c)(10), submission of a paper after a Notice of Allowance has been mailed are failures to engage in reasonable efforts to conclude prosecution. The period of adjustment set forth under 37 C.F.R. § 1.703 shall be reduced by the lesser of the number of days beginning on the date a paper (such as an amendment under 37 C.F.R. § 1.312) was filed and ending on the mailing date of the Office Action (or notice in response to the amendment under 37 C.F.R. § 1.312) or 4 months. Thus, under 37 C.F.R. § 1.704(c)(10), the period between submission of a Request for Continued Examination on April 27, 2005 (*i.e.*, after the Notice of Allowance was mailed) and the mailing of the next Office Action (*i.e.*, July 5, 2005) is a failure to engage in reasonable efforts to conclude prosecution. This period (April 27, 2005 to July 5, 2005) is **69 days**.

(3) According to the PTA History, an "Amendment After Notice of Allowance (Rule 312)" was filed on June 9, 2005 and a "Response to Amendment Under Rule 312" was mailed on June 29, 2005. Under 37 C.F.R. § 1.704(c)(10) as summarized above in (2), the period of adjustment set forth under 37 C.F.R. § 1.703 shall be reduced by the lesser of the number of days beginning on the date an amendment under 37 C.F.R. § 1.312 was filed and ending on the mailing

date of the notice in response to the amendment under 37 C.F.R. § 1.312 or 4 months. Applicants respectfully submit that 37 C.F.R. § 1.704(c)(10) does not apply in the instant case because a Request for Continued Examination was filed on April 27, 2005 (*i.e.*, before the "Amendment After Notice of Allowance (Rule 312)" on June 9, 2005 was filed.) Thus, classification of the June 9<sup>th</sup> amendment as an amendment after Notice of Allowance is incorrect. In sum, for the purposes of calculating delays under 37 C.F.R. § 1.704(c)(10), Applicants assert that the "Amendment after Notice of Allowance (Rule 312)" of June 9, 2005 in the PTA History is not an amendment under 37 C.F.R. § 1.312 because a Request for Continued Examination was filed on April 27, 2005 and should not be considered a failure to engage in reasonable efforts to conclude prosecution.


(4) Thus, under 37 C.F.R. § 1.704, the total period for failures to engage in reasonable efforts to conclude prosecution is the sum of (1) above (213 days) and (2) above (69 days) (*i.e.*, **282 days**; 213 days + 69 days = 282 days) and may be subtracted from the sum of the periods calculated under 37 C.F.R. § 1.703 (*i.e.*, **342 days**). *See*, 37 C.F.R. § 1.703(f).

#### Conclusion

For all of the foregoing reasons, Applicants submit that this application is entitled to a net Patent Term Adjustment of 60 days to date (*i.e.*, the difference between the sum of the periods calculated under 37 C.F.R. § 1.703 (*i.e.*, 342 days) and the sum of the periods calculated under 37 C.F.R. § 1.704 (*i.e.*, 282 days)). Applicants respectfully request that this application be granted, and that the patent issuing from this application be accorded the appropriate net period of Patent Term Adjustment set forth above.

Respectfully submitted,

Dated: February 2, 2006

By   
Shelly M. Fukawa, Ph.D. (Reg. No. 56,190)  
DARBY & DARBY P.C.  
P.O. Box 5257  
New York, New York 10150-5257  
(212) 527-7700  
(212) 753-6237 (Fax)  
Attorneys/Agents For Applicant